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MEINICKE DIAZ, SUSANNA M				
ART UNIT		PAPER NUMBER		
3692				
NOTIFICATION DATE		DELIVERY MODE		
07/09/2008		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/785,330

Applicant(s)

BUXTON, OLLY

Examiner

Susanna M. Diaz

Art Unit

3692

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This final Office action is responsive to Applicant's amendment filed April 7, 2008.

Claim 1 has been amended.

Claim 3 has been added.

Claims 1-3 are presented for examination.

2. The previously pending rejections under § 112, 2nd paragraph are withdrawn in response to Applicant's claim amendments; however, new rejections are asserted below in response to the claim amendments.

Response to Arguments

3. Applicant's arguments with respect to claims 1-3 have been considered but are moot in view of the new and revised ground(s) of rejection, which are necessitated by Applicant's claim amendments.

Oath/Declaration

4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-3 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claim 1 has been amended to specify that the first issuer and second issuer act as a debtor; however, there is no support for this feature in the specification, claims, or drawings, as originally filed; therefore, the amendment in question constitutes new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1 recites that the first issuer and second issuer act as a debtor. It is not clear what the metes and bounds of "acting as a debtor" include, thereby rendering the claimed invention vague and indefinite.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bahar (US 2002/0143687 A1).

Bahar discloses a method implemented by a programmed computer system, comprising:

[Claim 1] inputting into a computer data regarding a first issuer bound by regulations of a first jurisdiction (Figs. 2, 4(b), 4(c), 5; ¶¶ 18, 19, 21, 31-33, 38-39, 43);

inputting into a computer data regarding a second issuer bound by regulations of a second jurisdiction, wherein the first jurisdiction and the second jurisdiction are distinct from one another (Figs. 2, 4(b), 4(c), 5; ¶¶ 18, 19, 21, 31-33, 38-39, 43 – In Fig. 4(b), items 1 and 2 fall under the jurisdiction of New York, NY, while Item 3 falls under New York, NY, Hackensack, NJ, and/or Miami, FL);

inputting into a computer data regarding a first multi-jurisdictional program contract entered into between the first issuer acting as a debtor and at least one multi-jurisdictional program contract counterparty for sale of at least one note issued by the first issuer, wherein each first multi-jurisdictional program contract counterparty is

selected from the group consisting of: a trustee, a principal paying agent, a custodian, a paying agent, a transfer agent, an arranger, a calculation agent, a disposal agent, a process agent and a swap counterparty (Figs. 2, 4(b), 4(c), 5; ¶¶ 18, 19, 21, 31-33, 38-39, 43 – The specific type of counterparty does not affect the structural elements or the manipulative steps of the claimed invention and therefore will not serve to patentably distinguish the claimed invention over the prior art, as discussed in more detail below);

inputting into a computer data regarding a second multi-jurisdictional program contract entered into between the second issuer acting as a debtor and at least one multi-jurisdictional program contract counterparty for the sale of at least one note issued by the second issuer, wherein each second multi-jurisdictional program contract counterparty is selected from the group consisting of: a trustee, a principal paying agent, a custodian, a paying agent, a transfer agent, an arranger, a calculation agent, a disposal agent, a process agent and a swap counterparty (Figs. 2, 4(b), 4(c), 5; ¶¶ 18, 19, 21, 31-33, 38-39, 43 – The specific type of counterparty does not affect the structural elements or the manipulative steps of the claimed invention and therefore will not serve to patentably distinguish the claimed invention over the prior art, as discussed in more detail below);

inputting into a computer data regarding the purchase of each note by a noteholder (¶¶ 29-37 – Bids to purchase each note are entered);

calculating with a computer payments due each noteholder based at least in part upon the input data regarding the purchase of each note (¶¶ 29-37 – Bids to purchase

each note are entered. The winning bid indicates payments due upon purchase of each note); and

processing the calculated payments to provide the payments to the noteholders (¶¶ 35, 37; Bad debt items are sold to the winning bidder, thereby implying that payments to the noteholders are made in exchange for the bad debt items);

[Claim 2] wherein each first multi-jurisdictional program contract counterparty is the same entity as each corresponding second multi-jurisdictional program contract counterparty (Fig. 4(b); ¶¶ 31-33 – A single party may purchase various bad debt items in the form of a lot);

[Claim 3] wherein the steps are carried out in the order recited (Figs. 6(a)-6(c)).

It is noted that most of the details recited in claims 1-3 do not affect the scope of the manipulative steps of the invention. The first four steps of independent claim 1 involve the steps of inputting data into a computer; however, the details of the data amount to non-functional descriptive material. Even though Bahar does not explicitly disclose all of the details of the inputted data, these differences are only found in the non-functional descriptive material and are not functionally involved in the manipulative steps of the invention nor do they alter the recited structural elements; therefore, such differences do not effectively serve to patentably distinguish the claimed invention over the prior art. The manipulative steps of the invention would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the

claimed invention from the prior art in terms of patentability as the claimed invention fails to present a new and unobvious functional relationship between the descriptive material and the substrate, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)); *In re Ngai*, 367 F.3d 1336, 1336, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004); MPEP § 2106. For example, the fact that the first and second issuers act as debtors has no bearing on how data is inputted in the first four limitations of claim 1 nor is the inputted data in the first four limitations specifically used to perform any subsequent functionality that is intrinsically dependent on the particular type of data entered in the first four limitations of claim 1. The fifth step of "inputting into a computer data regarding the purchase of each note by a noteholder" does require purchase data that is subsequently utilized in the calculating step since the input purchase data is specifically used to calculate payments due each noteholder. Consequently, this input purchase data is specifically addressed by the applied prior art. The processing step of claim 1 also clearly defines a manipulative step of the invention. Claim 2 clarifies that "each first multi-jurisdictional program contract counterparty is the same entity as each corresponding second multi-jurisdictional program contract counterparty"; however, the nature of the counterparties does not have any bearing on how the manipulative steps of the invention are performed. Furthermore, many of the recited claim details merely reflect contractual terms and agreements. Beyond inputting various pieces of data, the main manipulative steps of the claimed invention involve calculating payment due each noteholder and processing the calculated payments to the noteholders. To perform these manipulative

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steps of the claimed invention, only "data regarding the purchase of each note by a noteholder" is required to complete the recited calculation. The nature of the various entities recited does not affect how data is inputted or any of the calculations or processing of payments; therefore, the descriptive details of the recited entities will not serve to patentably distinguish the claimed invention over the prior art unless such descriptive details are somehow recited in a manner that is specifically crucial to the operation of a manipulative step or steps of the claimed invention.

Double Patenting

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 1-3 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application

No. 11/175,501. Claims 1-3 of the instant application are fully anticipated by claims 1-3 of copending Application No. 11/175,501. Elimination of an element or its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions (see *In re Karlson*, 136 USPQ 184, 186; 311 F2d 581 (CCPA 1963)).

This is a provisional obviousness-type double patenting rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 8 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kambiz Abdi can be reached on (571) 272-6702. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Susanna M. Diaz/
Primary Examiner, Art Unit 3692